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09/178,329	10/23/1998	MICHAEL R. NOWAK	E4919-00003	4360

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DUANE MORRIS LLP - Philadelphia
IP DEPARTMENT
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

EXAMINER

JACKSON, MONIQUE R

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1787

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/178,329
Filing Date: October 23, 1998
Appellant(s): NOWAK ET AL.

Richard A. Paikoff
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/3/10 appealing from the Office action mailed 10/7/09.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application No. 10/094,060, Appeal 2009-009885.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 25, 26, 28-35 and 37-58.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

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REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

4,254,173 PEER Jr. 3-1981

Admitted Prior Art, Instant Specification, Pages 1-2.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 25, 26, 28-35 and 37-58 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Peer Jr (USPN 4,254,173.)

The admitted prior teaches a ream of paper wrapped by a wrapping material comprising a paper layer and polymer and/or wax coating, particularly polyethylene coating, to provide a moisture barrier for the ream of paper (Pages 1-2 of the instant specification), but does not teach that the wrapping material is formed from a pre-formed polymer coating film adhered to the paper layer with an adhesive and is printed before lamination as in instant Claim 25. However, Peer Jr teach a composite material for packaging comprising a paper substrate laminated to a plastic film via an adhesive layer wherein the pre-formed plastic film provides improved tear resistance and higher strength to the paper composite, and wherein the plastic film is preferably transparent to permit reverse printing on the inner surface, prior to lamination of the composite, and provides abrasion resistance to the printed decoration visible through the film (Abstract; Col.

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8, lines 40-60.) Peer Jr teach that the plastic film is preferably polyethylene, polypropylene, polyester, polyvinylchloride or cellophane; and the adhesive may selected based upon compatibility with the film but is preferably molten polyethylene (Abstract; Col. 4, lines 1-19.) Hence, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any polymer coated paper composite packaging material for the wrapped ream of paper taught by the admitted prior art wherein Peer Jr specifically teach a composite as instantly claimed provides improvements over other packaging materials, particularly improved tear resistance, higher strength, and abrasion resistance for decoration printed on the plastic film via reverse printing prior to lamination and visible through the film.

With regards to further dependent claims, Peer Jr teach that pigments and other additives can be added if desired, wherein the Examiner takes the position that wax is a conventional additive utilized in the art as evidenced by the admitted prior art (reads upon Claims 29, 31, 38, 40, 46, 48, 54 and 56; Col. 4, lines 6-9.) With respect to the metallized material limitation of Claims 32, 41, 49, and 57, Peer Jr further teach that after printing, the plastic film can be metallized (Col. 3, lines 31-35.) With respect to Claims 34 and 51, wherein the paper substrate is printed vs. the polymer film, the Examiner takes the position that the final end product having an intermediate print layer would be the same regardless of which layer is printed, hence a printed decoration visible through the transparent film. In addition, it would have been obvious to one having ordinary skill in the art to provide print on the inner surface of the paper, if desired, for decorative purposes, given the reasonable expectation of success and predictable results wherein the resulting printed image would still be present between the paper and the film

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as taught by Peer Jr and would be provided with abrasion resistance due to the plastic film covering the printed image.

(10) Response to Argument

First, the Examiner notes that the Appellants appear to be arguing the Peer Jr. reference as the primary reference however the Examiner notes that the rejection was based upon the admitted prior art as the primary teaching of a wrapped ream of paper wrapped with a polymer coated paper composite wrap material, and Peer Jr. as a secondary teaching providing the support and motivation to utilize a pre-formed polymer film as opposed to the polymer coating on the paper substrate for the wrap material in order to provide improved tear resistance and strength, as well as abrasion resistance to a decorative image printed between the transparent polymer film and paper substrate and viewable through the transparent film. With regards to Appellants' arguments that Peer Jr. is directed to secondary container packaging material, the Examiner first notes that Peer Jr. is directed to packaging material in general, with "secondary container packaging" being more particularly described and specifically recites that though "the invention concepts have been disclosed with reference to an illustrative and presently preferred embodiment thereof, it is intended that the appended claims be construed as including alternative embodiments" wherein Peer Jr. also teach the use of the polymer/paper composite for labels as well as container packaging in general (see Col. 1, line 6-9; Col. 1, line 54-Col. 2, line 5; Col. 7, lines 1-32; Col. 8, lines 53-68; Claims.) Further, contrary to Appellants' arguments, the rejection does not suggest modifying the teachings of Peer Jr. but instead looks to Peer Jr. for the motivation to utilize a pre-formed polymer film vs. a polymer coating in making polymer/paper composite packaging material given that the use of such pre-formed polymer film in the

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polymer/paper packaging material provides improved tear resistance and strength at lower cost as taught by Peer Jr., as well as abrasion resistance to a decorative image printed between the polymer film and paper substrate prior to lamination. Therefore, given that Peer Jr. is directed to polymer/paper composite packaging materials, which is the same field of Appellants' endeavor, and is also reasonably pertinent to the particular problem with which the Appellants were concerned, Appellants' arguments with regards to "secondary container packaging" are not persuasive. With regards to Appellants' arguments in the last paragraph of Page 6 of the Appeal Brief, the Examiner notes that Finestone et al did not form any basis of the current rejection and as discussed above, Peer Jr. specifically teaches printing prior to lamination.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Monique R Jackson/

Primary Examiner, Art Unit 1787

Conferees:

/Benjamin L. Utech/

Primary Examiner

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787

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